

REMARKS/ARGUMENTS

Objections in the Specification.

The Examiner objected to the specification by alleging that the disclosure contained embedded hyperlinks and/or browser-executable code. In the amendment of July 15, 2004, the Applicant filed a replacement specification which deleted embedded hyperlinks and/or browser-executable code. MPEP § 608.01 states, "examples of a hyperlink or a browser-executable code are a URL placed between these symbols "< >" and http:// followed by a URL address."

The following is an example of a reference with an embedded hyperlink and/or browser-executable code:

<http://www.altavista.com/>

The following reference is **NOT** an embedded hyperlink and/or browser-executable code:

www.altavista.com

Without the "< >" symbols and the "http://" characters included in a reference, a browser does not interpret the text as a valid HTML code, it will not become a live web link, (See MPEP § 608.01.) and is therefore acceptable for patent disclosures. Because the Applicant already removed the embedded hyperlinks from the disclosure, the Applicant kindly requests that the objection to the disclosure be removed.

CLAIMS

Claims 1-27 are currently pending in this application. Claim 19 is currently amended. Claims 1, 12, 19, and 25 are independent claims. Applicant kindly requests favorable reconsideration of the application in view of the amendments and the following discussion.

Claim 19 was amended to help in understanding applications of the invention, and help in understanding the meaning and context of the remaining independent claims. The present invention is not a search engine, but is a method and system that interacts with a search engine. This is plainly evident from the independent claim language. The independent claims teach a step of transmitting a created document to a search engine. If

the invention were a search engine then it would not be logical to claim that the invention transmits a document to a search engine. If the invention were a search engine it would already have the document and there would be no need to transmit the document to a search engine. None of the claims describe the invention as a search engine. Claim 19 was amended to illuminate this by claiming one embodiment of the invention.

Claim 19 was amended to claim that a web server is executing the process steps of the invention. Support for a web server embodying the present invention is found in the specification in paragraphs 0041, 0048, 0008, and 0009. Claim 19 now claims that it is a web server, or server computer, that denies access to the search engine requesting secure or rights protected documents.

Considering the reference combination cited against the present invention, it appears that the present invention is not understood. The invention is not a search engine, and search engines do not directly relate to the present invention. Yet the references cited against the present invention are both search engine inventions. Kirsch is a "Real-time Document Collection Search Engine with Phrase Indexing." Billmers is a "Method and Apparatus for Filtering Incoming Information Using a Search Engine and Stored Queries Defining User Folders."

The following tables show the process used in the present invention, and illuminate the novel process invented by the applicant.

Prior Art Process 1a - A Search Engine indexing un-protected content	
<i>Web Server Side</i>	<i>Search Engine Side</i>
(1a) Web Server maintains content fully accessible by a Search Engine.	← (2a) Search Engine requests full access to web content. (4a) Search Engine analyzes received content. (5a) Search Engine parses content. (6a) Search Engine indexes content. (7a) Search Engine stores indexed content in Search engine Database for user queries.
(3a) Web Server sends Search Engine the full requested content. →	

Prior Art Process 1b - A Search Engine trying to access secure content.

<i>Web Server Side</i>	<i>Search Engine Side</i>
(1b) Web Server maintains secure content not accessible by a Search Engine. (3b) Web Server denies Search Engine the requested content.	← (2a) Search Engine requests full access to web content.

Process of Present Invention

<i>Web Server Side</i>	<i>Search Engine Side</i>
(1) Web Server maintains secure content not accessible by a Search Engine. (3) Web sever does not grant full access (4) Web Server analyzes secure content. (5) Web Server converts secure content into index information. (6) Web server structures index information as the requesting search engine would structure the index information. (7) Web Server dynamically creates a document using this structured index information. (8) Web Server transmits dynamically created document to Search Engine. →	← (2) Search Engine requests full access to web content. (9) Search Engine can copy indexed information from created document directly to its Search Engine database.

It is possible to tell by the location of the steps in the preceding tables that the present invention operates on the opposite side of the search engine equation. With the present invention, most of the steps are on the web server (left) side of the table. With the prior art, most of the steps are on the right side of the table. Billmers, Kirsch, and any background discussion in the disclosure of the present invention teach either Process 1a or Process 1b.

Not one of the prior art documents suggests these steps as performed on the web server side.

Claim 19

The Examiner has asked the Applicant to show that claim 19 is patentable over Kirsch in view of AAPA. As required, by M.P.E.P § 2143:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure.

The combination of Kirsch and AAPA fails to establish a prima facie case of obviousness because the combination does not teach or suggest all the claim limitations as required by M.P.E.P § 2143.

Claim 19 teaches "reading index information, wherein the index information is structured for use in an index database of a search engine." It is evident from the claim language and disclosure that a search engine does not perform this step. The Examiner, however, cites Kirsch Abstract and col.3, lines 48-64. This reference citation can be put in context by reading Kirsch at col. 3 starting at line 42, "a general purpose of the present invention is to provide a fast response document collection search engine." Thus Kirsch merely teaches a search engine performing certain steps and contains no suggestion of the limitation of the present invention. The citations from Kirsch for the remaining limitations of Claim 19 are all similarly inapplicable.

The disclosure was erroneously interpreted as prior art.

The Examiner also cites the disclosure of the present invention, paragraphs 0008-0009, as teaching reading index information that is associated with a secure graphical or audio object, wherein the index information is structured for use in an index database of a search engine, and that a search engine does not have full access to the secure graphical or audio object. The disclosure, however, teaches the opposite.

First, neither the disclosure nor Kirsch teaches reading index information. They both teach that search engines only read full content. Second, the disclosure does not teach reading this information, but instead teaches "all other applications are prevented from accessing the protected document" (paragraph 0009). Paragraph 0010 continues "one way to solve this problem is to retrofit all pre-existing IR systems so that they are 'rights-enabled'." When the disclosure mentions solving a **problem**, that means there is a

problem with the prior art because the prior art doesn't teach the solution. The AAPA does not teach the claim limitation as the Examiner suggested. The reference combination fails to teach all of the claim limitations and therefore the Examiner has not established a prima facie case of obviousness. Therefore claim 19 is patentable over the reference combination and is believed to be in condition for allowance.

Claims 20-24

Claims 20-24 each depend on claim 19. As discussed above, claim 19 is patentable over the reference combination. If an independent claim is patentable, then all claims that depend therefrom are also patentable. Thus claims 20-24 are also patentable over Kirsch in view of AAPA for the same reasons that claim 19 is patentable over the reference combination. Claims 20-24 are therefore believed to be allowable.

Claim 1 & 12

For independent claims 1 and 12, the examiner incorporated the rejection of claim 19. As discussed above, claim 19 is patentable over the reference combination. Claim 1 and 12 contain similar limitations as claim 19 such as transmitting to a search engine. The reasons for claim 19 being patentable are applicable to claims 1 and 12 and are incorporated by reference. Therefore claims 1 and 12 are patentable over the reference combination and believed to be allowable.

Claims 2-11, and 13-18

Claims 2-11 depend on claim 1, and claims 13-18 depend on claim 12. As discussed above, claims 1 and 12 are patentable over the reference combination. If an independent claim is patentable, then all claims that depend therefrom are also patentable. Thus claims 2-11 and 13-18 are also patentable over the reference combination for the same reasons that claims 1 and 12 are patentable over the reference combination. Claims 2-11 and 13-18 are therefore believed to be allowable.

Claim 25

For independent claim 25, the Examiner incorporated the rejection of claim 19. As explained above the rejection of claim 19 was erroneous and the reference combination fails to establish a prima facie case of obvious. For claim 25 the Examiner also cited Billmers as teaching converting at least a portion of a graphical or audio object into index information. A review of Billmers reveals that neither the term "graphical object" nor the term "audio" appear in the disclosure of Billmers. In addition to the rejection of claim 25

being based on an erroneous reference combination, Billmers does not teach the additional limitations. Furthermore, Billmers, like Kirsch, merely teaches a search engine and does not directly relate to the present invention. Because the reference combination does not teach or suggest all of the claim limitations, the reference combination fails to establish a prima facie case of obviousness. Claim 25 is therefore patentable over the reference combination and believed to be in condition for allowance.

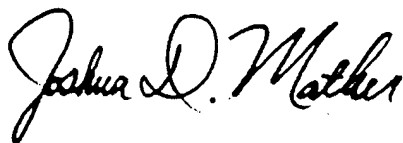
Claims 26 & 27

Claims 26 and 27 each depend on claim 25. As discussed above, claim 25 is patentable over the reference combination. If an independent claim is patentable, then all claims that depend therefrom are also patentable. Therefore claims 26 and 27 are also patentable over Billmers in view of AAPA, and further in view of Kirsch for the same reasons that claim 25 is patentable over the reference combination. Claims 26 and 27 are believed to be in condition for allowance.

Summary

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully Submitted,



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